

REMARKS

Summary

Claims 1 and 3-48 are pending. Claims 3-6, 8-12, 14-17, 20-22, 26-30, 32-36, 38-41, and 46 are amended. No new matter is added.

Rejections Under 35 USC 112

Claims 20-24 are rejected under 35 USC 112, second paragraph, as being indefinite. Claims 20 and 21 are amended herein to address the rejections. Thus, Applicants respectfully request reconsideration and withdrawal of the rejections.

Rejections Under 35 USC 103

Claims 1-48 are rejected under 35 USC 103(a) over US Patent No. 6,331,867 to Eberhard et al. (Eberhard). Applicant respectfully requests reconsideration of the rejections in light of the amendments to the claims and the remarks below.

Claim 1 provides a computer implemented method comprising determining a context to be applied to an electronic mail message; identifying one or more elements within the electronic mail message based at least in part upon the context; and associating one or more semantic qualifiers with the one or more elements to provide contextualization of at least a portion of the electronic mail message.

The Office Action cites Eberhard for teaching or suggesting all the elements of claim 1, however, Eberhard fails to teach at least one feature of claim 1, and thus claim 1 is patentable over Eberhard.

Eberhard provides an electronic reading device that has interactive features that allow for terms within the text of the book being read to be selected to thus enable the lookup of the selected terms in a reference book (dictionary, encyclopedia, etc.). The reference materials (not the books/text) are tagged such that terms that are selected may be found (if present) in the reference materials. Such an operation works substantially similar to the way MS Word provides a lookup of terms in the associated thesaurus.

However, such an operation is quite different from that provided by pending claim 1.

Claim 1 is limited to use with an electronic mail message, which embodies certain elements of functionality not contemplated, taught, or suggested by Eberhard. While Eberhard discusses the ability to link its reading function to an email system, there is no lookup function and more importantly no contextualization function (such as provided in claim 1) that is integrated in any way with the email system mentioned in Eberhard. This limitation of Eberhard is acknowledged in the Office Action, but the limitation is simply disregarded in the Office Action by stating that the integration of the lookup function is obvious. Applicant disagrees. The contextualization of elements within an email message provides for transmission of the contextualization, which clearly does not fit within the express purpose of the lookup function of Eberhard which requires the accessibility of the reference materials which must be specifically downloaded to the device. So, Eberhard clearly does not provide a teaching for use of contextualization within an email message, since, in accordance with the teachings of Eberhard, enabling accessibility at both ends of the message would require the sender and recipient to both maintain the same reference materials locally. Such a description is in no way taught or suggested.

In addition, claim 1 provides in the first operation that a context is determined for the message. At no point in Eberhard is there provided a context for a message or even for the book/text described therein. As used in the present Specification, a context describes the framework for the message, such as "related to an episode of care" or "medical-related" which helps categorize the message and distinguish the message from another context (for example, one dealing with a billing issue, personnel, etc.). The Office Action indicates that Eberhard provides such a teaching because the user selects a particular passage within the text of the book being read. This clearly has little to do with determining a context for the message. As further described in the present Specification (and recited in claim 1 as discussed below), the identification of the context (for example, related to an episode of care) in turn identifies or facilitates in the identification of the elements to which a semantic qualifier may be associated. As

recited in claim 1, the particular elements within the message (for example, words in the message) are identified based on this context (the categorization of the type of message). Thus, as an example, if a message were related to an episode of care, the particular identified elements may include the patient's name, chief complaint, etc. It is those items that are "based at least in part upon the context" and thus may be associated with the one or more semantic qualifiers.

In Eberhard, the lookup of terms is not based on any context, but rather is simply a lookup (for example, a definition) of the term absent any correlation to the particular text or context of the passage. The different approach in claim 1 provides benefits not contemplated, taught or suggested in Eberhard including post-processing of the electronic mail messages, semantic based searching, and/or grouping/categorization of messages or content elements.

Thus, based on the different functions and the different results derived therefrom, Eberhard clearly fails to teach all the features of claim 1, and claim 1 is therefore patentable over Eberhard.

Independent claims 13, 20, 25, 37, and 44 contain language similar to that of claim 1 and thus are patentable over Eberhard for at least the same reasons as discussed above for claim 1.

Claims 3-12, 14-19, 21-24, 26-36, 38-43, and 45-48 depend from claims 1, 13, 20, 25, 37, or 44, directly or indirectly, and are thus patentable over Eberhard for at least the reasons discussed above.

Claims 2-12, 14-17, 26-36, and 38-41

Claims 2-12, 14-17, 26-36, and 38-41 were not substantively examined as the assertion in the Office Action is that the identified claims merely consist of non-functional descriptive material. While Applicants respectfully disagree, Applicants have amended claims 3-6, 8-12, 14-17, 26-30, 32-36, and 38-41 to better present the language of the claims. Applicants assert that the claims as presented provide clearly functional and distinct features not provided in the cited reference.

Claims 22-24 and 47-48

The subject matter of claims 22-24 and 47-48 (and presumably claim 46) were largely overlooked as the Office Action simply states that the format of an email message is known in the art. However, claims 22-24 and 46-48 do not simply recite the format of an email message, but additionally provide for the location of the selected one or more words (claims 22 and 46). Claims 23-24 and 47-48 further indicate the location (in the email message header or body) of the semantic qualifiers based on the selected one or more words from the body section of the email. Such a relationship of the elements is far different from simply a recitation of the format of an email message. Applicants assert that the claims as presented provide clearly distinct features not provided in the cited reference.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1 and 3-48 are in condition for allowance. Early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
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